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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,350	10/31/2000	Fuad Mehraban	10716-15	3065
23552	7590	08/10/2005	(CURA-90/P1891R1)	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER NICKOL, GARY B	
			ART UNIT 1642	PAPER NUMBER
DATE MAILED: 08/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,350

Applicant(s)

MEHRABAN ET AL.

Examiner

Gary B. Nickol Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56 and 69-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56 and 69-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Response to Amendment

The Amendment filed May 24, 2005 in response to the Office Action of November 24, 2004 is acknowledged and has been entered.

Claims 56, and 69-76 are pending and are currently under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Priority

Applicants request (Response, page 4) that the Examiner acknowledge the claim for priority to 60/162,669 filed November 1, 1999 and 60/196,802 filed April 13, 2000. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. Applicants earliest date for priority purposes is November 1, 1999.

Information Disclosure Statement

The previously filed information disclosure statements of 09-02-2004 and October 1, 2002 have been considered. In addition, the supplemental IDS filed 05-24-05 has been considered.

Rejections Maintained:

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Claims 56 and 69 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 9, and 10 of copending Application No. 10/824,075 for the reasons of record. Applicants request (page 5) that the Examiner hold this rejection in abeyance until notice of allowable subject matter. This request is noted, however, the rejection is maintained.

Claims 56, and 69-76 remain rejected under 35 U.S.C. 102(e) as being anticipated by Olsen *et al.* (US2002004237A1, 10-27-1999) for the reasons of record. Applicant's arguments have been carefully considered but are not found persuasive. The prior art clearly teaches methods for treatment of diseases or disorders associated with neovascularization by administration of the stanniocalcin polynucleotides and/or polypeptides of the invention, as well as agonists or antagonists of stanniocalcin [para 422] wherein antibodies of may act as agonists or antagonists of the polypeptides [para 0129]. Thus, applicant's arguments have not been found persuasive, and the rejection is maintained.

New Rejection:***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 56, and 69-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to a method for inhibiting angiogenesis in a mammal comprising administering to the mammal an effective amount of an antibody or antigen binding fragment thereof that specifically binds: "*an immunogenic fragment of a protein comprising at least ten amino acids of SEQ ID NO:76*". Thus, the claims are inclusive of antibodies that are specific to a genus of any protein fragments in the world that have at least any ten amino acids in common with SEQ ID NO:76.

However, the written description in this case only sets forth an antibody or antigen binding fragment thereof that specifically binds to the amino acid sequence SEQ ID No: 76. The written description does not extend to unrelated peptide fragments that were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. To reiterate, part (b) of Claim 56 includes *any* peptide segment in the world that has at least ten amino acids in common with the polypeptide of SEQ ID NO:76. This would broadly include peptide segments that are not related to the functional characteristics of the described stanniocalcin precursor, SEQ ID NO:76 (page 25, lines 10+ of the specification). Hence, applicants have claimed, but not described, a genus of unrelated, naturally occurring peptide segments. Some of the factual considerations that are weighed when determining a written

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description include the level of skill and knowledge in the art, the disclosure of complete or partial structures, the disclosure of physical and or chemical properties, adequate disclosure of the functional characteristics, the correlation between structure and function, and disclosure of methods of making. In the instant case, the specification (page 25) only adequately describes the complete chemical, structural, and functional properties of a single reference polypeptide. Thus, because the genus of fragments that comprise at least ten amino acid segments is highly variant, one of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe and enable the genus as broadly claimed. *Vas-Cath Inc. v. Mahurkar*, 19USPQ2d 1111, clearly states “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” (See page 1117.) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116).

No claim is allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary B. Nickol Ph.D.
Primary Examiner
Art Unit 1642

GBN



GARY B. NICKOL, PH.D.
PRIMARY EXAMINER